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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEWIS, JUSTIN V

ART UNIT

PAPER NUMBER

3725

NOTIFICATION DATE

DELIVERY MODE

07/01/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,001	<b>Applicant(s)</b> GOUELIBO ET AL.	
	<b>Examiner</b> JUSTIN V. LEWIS	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10 August 2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-9, 11-18 and 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,697,649 to Dames et al. ("Dames") in view of U.S. Patent No. 6,533,325 to Steidinger ("Steidinger '325").

Regarding claim 1, Dames discloses a method of manufacturing elements of relatively small size, especially such as planchettes (see abstract), comprising the following steps: i) a wound sheet is unwound (see col. 8, lines 10-12), then; ii) optionally, this sheet is printed at least partly on at least one side and then (see claim 25); iii) the sheet is cut deeply "right through" (see col. 7, lines 15-19) along a

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succession of at least two cutting patterns that intersect so as to constitute a resulting pattern that will form a detached element constituting the element of relatively small size (see fig. 2); and iv) the detached elements that form said elements of relatively small size are recovered (see claim 4), but fails to disclose the cutting operation taking place by means of a succession of synchronized cutting cylinders carrying one of the cutting patterns respectively, anvil cylinders being interposed between these cutting cylinders, the sheet passing between all these cylinders.

Steidinger '325 teaches the concept of providing a cutting operation taking place by means of a succession of synchronized cutting cylinders carrying a cutting pattern, anvil cylinders being interposed between these cutting cylinders, and a sheet passing between all these cylinders (see col. 13, lines 9-26).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to replace the Dames dies with the Steidinger rotary die cutting station in order to permit the convenient removal of the planchettes from the roll and the provision of edges which are smooth to sight and touch, as explicitly taught by Steidinger '325 (see abstract).

Regarding claim 2, Dames in view of Steidinger '325 discloses the method as claimed in claim 1, wherein the steps are carried out in line (see Dames col. 8, lines 10-16 in view of the combination set forth in the rejection of claim 1, above).

Regarding claim 3, Dames in view of Steidinger '325 discloses the method as claimed in claim 2, but fails to specifically disclose the method being carried out at a speed of between 20 and 150 m/min. However, it has been held that "where the

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general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claim 4, Dames in view of Steidinger ‘325 discloses the method as claimed in claim 1, wherein said sheet is a sheet of paper, a sheet of nonwoven or a sheet of plastic, or a complex of these materials (see Dames col. 1, lines 22-23).

Regarding claim 5, Dames in view of Steidinger ‘325 discloses the method as claimed in claim 1, wherein the sheet is printed by flexography (see Dames col. 8, lines 11-13).

Regarding claim 6, Dames in view of Steidinger ‘325 discloses the method as claimed in claim 1, wherein the sheet is printed, but fails to specifically disclose the sheet being printed in an amount of 1 to 10 g/m<sup>2</sup> per side, preferably between 2 and 5 g/m<sup>2</sup> per side. However, it has been held that “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claim 7, Dames in view of Steidinger ‘325 discloses the method as claimed in claim 1, wherein the sheet is printed on only one side (see Dames claim 25, permitting the disposition of elements upon “at least one side”).

Regarding claim 8, Dames in view of Steidinger ‘325 discloses the method as claimed in claim 1, wherein the sheet is printed on both its sides (see Dames claim 25, permitting the disposition of elements upon “at least one side”) in succession by

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front/back registration in particular by turning the sheet over (see Steidinger '325 col. 12, line 66) or by reversing the rotation of a printing unit.

Regarding claim 9, Dames in view of Steidinger '325 discloses the method as claimed in claim 1, wherein said sheet has a thickness, but fails to specifically claim said thickness being between 5 and 110 micrometers. However, it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claim 11, Dames in view of Steidinger '325 discloses the manufacturing method as claimed in claim 1, but fails to specifically disclose the largest dimension of the detached element being between 0.5 and 6 mm, preferably between 1 and 4 mm. However, it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claim 12, Dames, as modified by Steidinger '325 (in the manner set forth in the rejection of claim 1, above), discloses a method of cutting out elements of relatively small size, especially such as planchettes (see Dames abstract), wherein, starting from a sheet, said sheet is cut deeply "right through," (see Dames col. 7, lines 15-19) continuously, along a succession of at least two cutting patterns that intersect so as to constitute a resulting pattern that will form a detached element constituting the element of relatively small size (see Dames fig. 2), this cutting operation taking place

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using a succession of synchronized cutting cylinders carrying one of the cutting patterns respectively, anvil cylinders being interposed between these cutting cylinders (see the combination set forth in the rejection of claim 1, above).

Regarding claim 13, Dames, as modified by Steidinger '325 (in the manner set forth in the rejection of claim 1, above), discloses a device for cutting out elements of relatively small size, especially such as planchettes (see Dames abstract), wherein it comprises a rotary cutting device comprising a succession of synchronized cutting cylinders having respective cutting threads, anvil cylinders being interposed between these cutting cylinders, the cutting threads on the cylinders being supplemented so as to form an entire figure when the cutting cylinders rotate in a synchronized manner and when suitably adjusted (see the combination set forth in the rejection of claim 1, above).

Regarding claim 14, Dames in view of Steidinger '325 discloses the cutting device as claimed in claim 13, wherein each cutting cylinder is a magnetic cylinder covered with a magnetizable flexible plate retained by demagnetization forces, especially made of steel, bearing the cutting threads (see Steidinger '325 col. 7, lines 50-57), but fails to disclose said cutting threads specifically being electrochemically etched. However, the process by which said cutting threads are etched fails to further limit the physical limitations of the cutting device that is the primary subject of the instant claim. Accordingly, said limitation will not be afforded patentable weight.

Regarding claim 15, Dames in view of Steidinger '325 discloses the cutting device as claimed in claim 14, wherein it includes a base anvil cylinder (see the combination set forth in the rejection of claim 1, above).

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Regarding claim 16, Dames in view of Steidinger '325 discloses a device for manufacturing elements of relatively small size, especially such as planchettes (see Dames abstract), wherein it includes a reel holder (see Dames col. 8, lines 10-12), a printing device, with at least one printing unit (see Dames col. 8, lines 11-13), and a cutting device described in claim 13 (see the combination set forth in the rejection of claim 1, above).

Regarding claim 17, Dames in view of Steidinger '325 discloses the device as claimed in claim 16, wherein it includes a printing device having at least two printing units (see Dames col. 8, lines 11-13) with a set of bars for turning the sheet over between the units (see Steidinger '325 col. 12, line 66).

Regarding claim 18, Dames in view of Steidinger '325 discloses the device as claimed in claim 16, wherein it includes a printing unit having at least two printing units (see Dames col. 8, lines 11-13) with a device for reversing the rotation of one of the printing units (dies, as provided in the combination set forth in the rejection of claim 1, above).

Regarding claim 20, Dames in view of Steidinger '325 discloses the manufacturing device as claimed in claim 16, wherein it includes an antistatic treatment device (note that any metallic component of the device chosen at random may be considered to be an "antistatic treatment device," as it will function to discharge any accumulated static electricity).

Regarding claim 21, Dames in view of Steidinger '325 discloses a security element of relatively small size, wherein it is obtained using the manufacturing and/or



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cutting methods described in claim 1 and in that it includes identification patterns observable to the naked eye (see Dames fig. 1).

Regarding claim 22, Dames in view of Steidinger '325 discloses the security element as claimed in claim 21, wherein it includes patterns chosen from patterns that are visible in natural light, visible under UV light, luminescent patterns, particularly fluorescent or phosphorescent patterns, which are detectable by near or intermediate infrared radiation, thermochromatic patterns, piezochromatic patterns, patterns based on DNA tracers, patterns that are optically variable, especially iridescent or based on liquid crystals or diffraction gratings or moire patterns or holograms, electromagnetic patterns, or combinations thereof (see Dames fig. 1).

Regarding claim 23, Dames in view of Steidinger '325 discloses the security element as claimed in claim 21, wherein it includes, beneath or alongside said patterns, printing of electromagnetic, especially magnetic, character and in particular continuous tracks or codes in the form of magnetic bits (see Dames col. 1, lines 37-43).

Regarding claim 24, Dames in view of Steidinger '325 discloses the security element as claimed in claim 21, wherein it includes chemical authentication reactants or reactants that reveal a specific event (see col. 6, lines 11-19).

Regarding claim 25, Dames in view of Steidinger '325 discloses a security element of relatively small size, wherein it is obtained using the manufacturing and/or cutting methods described in claim 1, and wherein the shape of said element is a security characteristic (see Dames col. 5, lines 43-50).

Regarding claim 26, Dames in view of Steidinger '325 discloses a security sheet comprising a fibrous substrate (see Dames col. 7, lines 26-30) which includes at least one security element of relatively small size obtained using the manufacturing and/or cutting methods described in claim 1 (see the rejection of claim 1, above).

Regarding claim 27, Dames in view of Steidinger '325 discloses a decorative sheet comprising a fibrous substrate (see Dames col. 7, lines 26-30), which includes at least one decorative element of relatively small size obtained using the manufacturing and/or cutting methods described in claim 1 (see the rejection of claim 1, above).

Regarding claim 28, Dames in view of Steidinger '325 discloses a security document comprising, as base, a sheet as claimed in claim 26 (see Dames col. 7, lines 26-30).

Regarding claim 29, Dames in view of Steidinger '325 discloses a package comprising a sheet as claimed in claim 26 (see Dames col. 7, lines 26-30).

Regarding claim 30, Dames in view of Steidinger '325 discloses a security element as claimed in claim 21, wherein the shape of said element is a security characteristic (see Dames col. 5, lines 43-50).

Regarding claim 31, Dames in view of Steidinger '325 discloses a security sheet comprising a fibrous substrate which includes at least one security element as described in claim 21 (see Dames col. 7, lines 26-30).

4. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dames in view of Steidinger '325 and further in view of U.S. Patent No. 6,350,342 to Steidinger et al. ("Steidinger '342").

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Regarding claim 10, Dames in view of Steidinger '325 discloses the method as claimed in claim 1, but fails to disclose the detached elements being recovered by stripping, in particular using a peel bar and suction.

Steidinger '342 teaches the concept of detached elements being recovered by stripping, in particular using a peel bar (see col. 5, lines 64-66) and suction (see col. 7, lines 50-54).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the Steidinger '342 into the apparatus of Dames in view of Steidinger '325 in order to provide a means of separating die cut planchettes from the roll from which they came, as explicitly taught by Steidinger '342 (see col. 5, lines 64-66).

Regarding claim 19, Dames in view of Steidinger '325, as modified by Steidinger '342 (in the manner set forth in the rejection of claim 10, above), discloses the manufacturing device as claimed in claim 16, wherein it includes, after the cutting device, a stripping device, in particular one using a peel bar and suction (see the combination set forth in the rejection of claim 10, above).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN V. LEWIS whose telephone number is (571)270-5052. The examiner can normally be reached on M-F 7:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/  
Supervisory Patent Examiner, Art Unit 3725  
/JVL/